

REMARKS

Claims 15-41, 43-57 and 104-110 are pending in the application. Claims 15, 18-22, 24, 32-37, 39, 41, 43, 48, 56-57 and 105-106 are amended herein. Claims 107-110 are new. No new matter is introduced by any amendment. Applicant respectfully requests reconsideration of all claims.

Claim 15 was objected to for lack of clarity between terms “a first loyalty program instrument” and “a loyalty program instrument”. Applicant has amended the latter term to read: “a computer readable loyalty program instrument.” Applicant requests that the objection be withdrawn.

Claims 15-22, 24-41, 43-46, 48-57 and 104-106 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,319,122 (“*Packes*”) in view of U.S. Patent No. 6,379,247 (“*Walker*”). Applicant respectfully traverses.

Claim 15 has been amended to distinguish over the teachings of these references. In particular, claim 15 now recites an initial step for

*“receiving in the gaming apparatus a first loyalty program instrument
storing computer readable data representing loyalty points earned from a
first activity not associated with the gaming apparatus”*

and a final step for

*“issuing to the patron a computer readable loyalty program instrument
storing the combined loyalty points thereon as computer readable data.”*

The amended portions of these steps are fully supported in the original specification, *e.g.*, at pars. 0059 and 0069 as documented in U.S. Publication 2003/0032474.

The Office Action on page 4 admits that *Packes* does not teach storing comp information directly on the loyalty instrument in a manner consistent with applicant’s invention. The Office Action then turns to *Walker* for teachings directed to storing information directly on a loyalty instrument, which in *Walker*’s disclosure consists of printing airline miles on a flimsy paper receipt. *Walker*, FIG. 3, item 328. *Walker* also contemplates awarding airline miles in the form of special poker chips. *Walker*, col. 5 lines 20-31. But nowhere does *Walker* teach or suggest storing combined loyalty points on a computer readable loyalty program instrument as computer readable data. On this basis applicant distinguishes the invention recited in claim 15 from the teachings of *Packes* and *Walker*. Applicant requests that the rejection of claim 15 be withdrawn.

Further with regard to claim 15, Applicant emphasizes that *Packes* in view of *Walker* cannot render obvious the initial *receiving* step because neither reference teaches or suggests receiving in the gaming apparatus a first loyalty program instrument storing computer readable data representing loyalty points earned from a first activity not associated with the gaming apparatus.

Although the Office Action cites to *Packes*'s at col. 12 lines 4-10 for teachings related to the initial *receiving* step, these teachings fall short of suggesting the invention now recited in claim 15. The teachings of *Packes* do not suggest that a player may earn non-gaming machine loyalty points and subsequently insert a loyalty program instrument (whether a tracking card or a paper receipt) into a gaming apparatus for credit or redemption of those non-gaming machine points. *Packes* in col. 12 lines 4-10 teaches that a player may "remove his player tracking card from a slot machine, then hand it to a dealer at a blackjack table ... to continue his gaming session that was initiated at the slot machine."

Applicant respectfully submits that handing a tracking card to a dealer cannot reasonably be interpreted as teaching receiving in a gaming apparatus a loyalty program instrument storing computer readable data representing loyalty points earned from a first activity not associated with the gaming apparatus. Applicant requests that the rejection of claim 15 be withdrawn.

Claims 16-35 depend from claim 15. The amendments to any of these claims do not add new matter and are made to improve clarity and antecedent accuracy. In view of the dependency, and for the reasons presented above in favor of patentability of claim 15, applicant requests withdrawal of the rejections of claims 16-35.

Claim 36 has been amended in a manner similar to what was done for claim 15. Claim 36 recites an initial receiving step for

receiving in the gaming machine a first machine readable loyalty program instrument storing loyalty points earned from a first activity not associated with the gaming machine;

and a final step for

issuing to the game player a machine readable loyalty program instrument storing the combined loyalty points thereon as machine readable data.

Packes in view of *Walker* neither teaches nor suggests the initial "receiving" step, and neither teaches nor suggests the final "issuing" step. Applicant reasserts here the above arguments in favor of patentability of claim 15. Applicant requests that the rejection of claim 36 be withdrawn.

Claims 37-41, 43-57 and 104 all depend from claim 36. The amendments to claims in this range do not add new matter and are made to improve clarity and antecedent accuracy. In view of the dependency, and for the reasons presented above in favor of patentability of claim 36, applicant requests withdrawal of the rejections of claims 37-41, 43-57 and 104.

Claim 23 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Packes* in view of *Walker* and in further view of U.S. Patent No. 5,761,647 (“*Boushy*”). Applicant respectfully traverses.

Claim 23 depends from claim 15. Applicant reasserts here the foregoing arguments in favor of patentability of claim 15. In view of the foregoing arguments and dependency, applicant requests that the rejection of claim 23 be withdrawn.

Claim 47 was rejected under 35 U.S.C. 103(a) as being unpatentable over *Packes* in view of *Walker* and in further view of U.S. Patent No. 5,816,918 (“*Kelly*”).

Claim 47 depends from claim 36. Applicant reasserts here the foregoing arguments in favor of patentability of claim 36. In view of the foregoing arguments and dependency, applicant requests that the rejection of claim 47 be withdrawn.

New claims 107-110 are fully supported in the original specification, *e.g.*, at pars. 0059 and 0069 as documented in U.S. Publication 2003/0032474. Each new claim further limits the scope of its corresponding independent claim by specifying whether the issued computer readable loyalty program instrument is the same instrument that was received by the machine in the initial *receiving* step and updated with the stored combined loyalty points, or whether it is a new instrument storing the combined loyalty points.

The claims are believed to be in condition for allowance. Accordingly, allowance of the claims at the earliest possible date is requested. If prosecution of this application can be assisted by telephone, the Examiner is requested to call the undersigned attorney at (510) 663-1100.

Applicant does not believe that any additional fees are required to facilitate the filing of this Amendment. However, if it is determined that such fees are due, please charge such additional fees to Deposit Account No. 504480 (Order No. IGT1P061).

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Should the Examiner believe that a telephone conference would expedite the prosecution of this application, the undersigned can be reached at the telephone number set out below.

Respectfully submitted,

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/Sean Burdick/

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